

### REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This Response is believed to be fully responsive to all issues raised in the Final Office Action mailed October 8, 2009.

Claims 1-3, 9-13, 15, 17, 18, 23-25, 31-37 and 45 are currently amended. Claims 4, 14, 22, 26 and 44 are canceled. Claims 1-3, 5-13, 15-21, 23-25, 27-43 and 45-46 are pending.

#### Amendments to Claims

As discussed in a telephonic conversation of December 3, 2009, to expedite prosecution and seek allowance of one or more of the independent claims, Applicant represents subject matter of dependent claims in the independent claims. Applicant submits that the amendments do not in any substantial way introduce new subject matter to the pending claims.

Applicant respectfully directs the Office to the subject matter of previously pending dependent claims 14, 22 and 44; noting that claims 14, 22 and 44 are now canceled. Per the amendments, all of the independent claims now recite a circular printed circuit board disposed between a volute of a compressor housing and a compressor wheel. Further, per the amendments, all of the independent claims now recite plugs arranged by intervals on a circle around the axis of the compressor housing.

#### Rejections under §103(a)

At item 2, page 2, the Office rejects claims 1-4, 10-12, 14, 23-26, 30-34, 36, 45 and 46 under §103(a) as being unpatentable over Allen et al (US patent 6449950) in view of Finger et al (US patent 6571558) or Hartel et al (US patent 6945757).

At item 23, page 12, the Office rejects claims 5-9 and 27-29 under §103(a) as being unpatentable over Allen et al in view of Finger et al or Hartel et al as applied to claim 1 further in view of Nestor (US patent 5147229).

At item 29, page 13, the Office rejects claims 13,15-26, 30, 31, 35 and 37-44 under §103(a) as being unpatentable over Allen et al in view of Finger et al or Hartel et al further in view of Woollenweber et al. (US patent 5904471).

As explained below, all of the independent claims include subject matter of dependent claims 22 and 44, which are now canceled. Accordingly, Applicant responds to the Office's rejection of dependent claims 22 and 44. Applicant respectfully requests reconsideration and allowance of the pending independent claims 1, 10, 23, 32 and 45 and their respective dependent claims.

#### 10 Response to Rejections: Claims 22 and 44

As all of the independent claims recite subject matter found in previously pending dependent claims 22 and 44. Below, Applicant presents evidence and arguments as to why these previously pending dependent claims are believed patentable over the cited references and design choice. Accordingly, Applicant submits that the pending independent claims are patentable for at least the same reasons.

In rejecting claims 22 and 44, the Office cites the Allen reference, the Finger reference or the Hortel reference and the Woollenweber reference. At item 38, page 15 of the pending Office Action, the Office states:

20 In re claim 22 and 44, Allen et al in view of Finger et al or Hartel et al further in view of Woollenweber et al disclose the claimed invention except mentioning that the circuit board is circular and it is located between compressor volute and compressor wheel. But this would have been obvious to one skilled in the art at the time the invention was made since to change the shape of the circuit board as desired based on design choice absent persuasive evidence that the particular configuration of the claimed container was significant, In re Dailey, 357 F.2d 669, 149 USPQ 47 CCPA 1966. In regard to the location of the circuit board this is also a design choice since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

#### *Persuasive Evidence of Significance*

In response, Applicant respectfully directs the Office to the instant application at page 3, which describes problems solved and advantages of the particular

exemplary configurations; specifically, (a) simplification to alleviate a need to thread lead wires, “for the power connection of the electric motor through one or more holes of the center housing” and (b) to alleviate a “need to pass boundary conditions for the guidance of the lead wires, e.g. like sharp edges, at which a short circuit of the lead wires may occur”. For at least this reason, Applicant contends that persuasive evidence exists in the record where this evidence is sufficient to overcome the concern expressed by *In re Dailey*.

*Clarification of In re Dailey*

10            *In re Dailey* addressed rejection of a claimed baby bottle having a flexible portion and a rigid portion to prevent admission of air and creation of a vacuum. The cited art (Matzen), used to reject the claims, described a baby bottle having a flexible portion and a rigid portion that operated in the same manner to solve the same problem (see, e.g., *In re Dailey*, 149 USPQ at 47).

15            The court found some claims distinguished over Matzen only in terms of the type of nipple opening employed while others “only in reciting ‘less than a hemisphere configuration’”. These latter claims (hemisphere configuration) were deemed “‘mere matter of choice’ not significantly novel over Matzen” (*In re Dailey* at 49).

20            Applicant submits that the subject matter of claims 22 and 44 cannot be reached by simply resorting to design choice per *In re Dailey*. Design choice, according to *In re Dailey*, requires the same solution to the same problem. Design choice must exist within these bounds (i.e., otherwise it’s not a design choice).

25            As the cited references do not recognize the problems elaborated at page 3 of the instant application (see (a) and (b) above), these references do not solve such problems and cannot provide a basis for design choice. Hence, Applicant contends that the Office’s rejection of claims 22 and 44 based on design choice is inappropriate given *In re Dailey*. For at least this reason, Applicant submits that the previously pending dependent claims 22 and 44 are patentable over the cited  
30            references and design choice and that the pending independent claims, as currently amended to recite subject matter of claims 22 and 44 are likewise patentable.

Conclusion

Pending claims 1-3, 5-13, 15-21, 23-25, 27-43 and 45-46 are believed to be in condition for allowance. Applicant respectfully requests reconsideration and prompt  
5 issuance of the present application.

Should any issue remain that prevents immediate issuance of the application, the Examiner is encouraged to contact the undersigned attorney to discuss the unresolved issue.

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Respectfully Submitted,

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